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In re application of :
Martin Schuessler : DECISION ON
Serial No. 09/662,849 : PETITION
Filed: September 15, 2000 :
For: SYSTEM FOR HEATING AND/OR CONVERTING AT LEAST ONE MEDIUM

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed May 3, 2006.

On July 27, 2005, a non-final office action was mailed to applicant rejecting all of the claims under 35 USC 103. A reply to the office action was filed by applicants on November 28, 2005. In the reply, applicants made amendments to the claims. A final office action was mailed by the office on May 3, 2006 containing new grounds of rejection. On May 10, 2006, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the May 3, 2006 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the non-final rejection of July 27, 2005, Claim 1 was rejected over Gonjo in view of Schuessler and Watkins. In the amendment filed by applicants, claim 1 was amended to include a feature of being modular and eliminating "one of an evaporator". The examiner modified the rejection of claim 1 to be Gonjo in view of Schuessler and Pow in the final office action of May 3, 2006. The Watkins and the Pow references were applied by the examiner to meet limitation that

the "insulating plates provided between the end plates and layers which are respectively adjacent to the end plates." This limitation was not added or amended by the applicant's response of November 28, 2005. There is no indication in record as to why the Watkins reference was replaced by the Pow reference to meet this limitation and that such replacement would have been necessitated by the amendment. Because the Pow reference was newly applied to only meet limitations which were not amended, the new ground of rejection in the final office action mailed May 3, 2006 is not deemed to be necessitated by amendment. Therefore, petitioner's argument that the new grounds of rejection were not necessitated by Applicant's amendments are persuasive.

Because the rejection of claim 1, based on a new ground of rejection, was not necessitated by amendment, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response continues to run from May 3, 2006. Extensions of time may be obtained to file any amendments.



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